

REMARKS**1. Formal Matters****a. Status of the claims**

Claims 21-23 and 32-36 are pending in this application.

2. Patentability Remarks**a. Claim Objections****(1) Claims 22, 32, and 34**

On page 4 of the Office Action, the Examiner objects to claims 22, 32, and 34 under 37 C.F.R. § 1.75 as allegedly being substantial duplicates of claim 21. Applicant respectfully disagrees.

Claims 21, 32, and 34 recite a sequence at least 70.9%, 79.2%, and 83.4% identical to SEQ ID NO: 3588 or an RNA equivalent thereof, respectively. In contrast, claim 22 does not recite a variant of SEQ ID NO: 3588. Applicant respectfully submits that in view of the difference in claim language, claims 21, 22, 32, and 34 do not “cover the same thing” as alleged by the Examiner. Accordingly, claims 22, 32, and 34 are not substantial duplicates of claim 21, but instead are related to different subject matter. In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw the objection to claims 22, 32, and 34.

(2) Claims 33 and 35

On page 4 of the Office Action, the Examiner objects to claims 33 and 35 under 37 C.F.R. § 1.75 as allegedly being duplicates of claim 23. Applicant respectfully disagrees.

Claims 33 and 35 recite a sequence at least 79.2% and 83.4% identical to SEQ ID NO: 3588 or an RNA equivalent thereof, respectively. In contrast, claim 23 recites a sequence at least 70.9% identical to SEQ ID NO: 3588. Applicant respectfully submits that in view of the difference in claim language, claims 23, 33, and 35 do not “cover the same thing” as alleged by the Examiner. Accordingly, claims 33 and 35 are not substantial duplicates of claim 23, but instead are related to different subject matter. In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw the objection to claims 33 and 35.

b. 35 U.S.C. § 102(e)

On page 2 and 3 of the Office Action, the Examiner maintains the rejection of claims 21, 23, 32, and 33 under 35 U.S.C. § 102(e) over Mounts *et al.* (U.S. Pat. Pub. No. 2007/0031850; hereafter “Mounts”). In the Office Action mailed on July 10, 2007, the Examiner asserted that Mounts teaches an isolated nucleic acid of 25 nucleotides in length comprising SEQ ID NO: 273968 and an isolated nucleic acid of 25 nucleotides in length comprising SEQ ID NO: 273971 that are 80% identical to a 23-nucleotide

region of SEQ ID NO: 3588. In Applicant's reply of August 10, 2007, Applicant claimed the benefit of U.S. Pat. Appl. No. 60/457,788 filed March 27, 2003 (hereafter the '788 application), which teaches the sequence of SEQ ID NO: 3588. In view of this priority information of SEQ ID NO: 3588, Applicant submitted that the rejection is rendered moot.

The Examiner now asserts that Fig. 877B of the '788 application is not present in the USPTO Private Pair system. The Examiner also asserts that the compact discs which contain Fig. 877B and were filed with the '788 application are not found in the application file. Applicant submits herewith Appendix A, which is a copy of Fig. 877B as filed with the '788 application, and Appendix B, which is a copy of the Provisional Application Cover sheet as received and stamped by the USPTO on March 27, 2003, acknowledging receipt of the '788 application and accompanying compact discs. In addition to the compact discs, Fig. 877B and its description can be found in the following folder and files on the submitted compact discs.

Folder Name: Description & Figs 17-2739 2741-3297\Figs17-2739, 2741-3297

File Names: fig-000877_001.tif

fig-000877_0002.tif

fig-000877_0003.tif

These files clearly indicate that SEQ ID NO: 3588 is disclosed in priority U.S. Pat. Appl. No. 60/457,788.

Figure 877B of U.S. Pat. Appl. No. 60/457,788 teaches the 24 nucleotide sequence as set forth in SEQ ID NO 3588. Applicant respectfully submits that in view of this evidence, Mounds is an improper §102(e) reference because Mounds has a priority date of June 3, 2003, in contrast to Applicant's priority date for SEQ ID NO: 3588 of March 27, 2003, as disclosed in U.S. Pat. Appl. No. 60/457,788. In view of the foregoing remarks, Applicant submits that the rejection of claims 21, 23, 32, and 33 under 35 U.S.C. § 102(e) is moot and should be withdrawn.

c. 35 U.S.C. § 103

On page 4 of the Office Action, the Examiner maintains the rejection of claims 21, 23, 32, 33, and 36 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mounds view of Paul et al., Nature Biotechnology 29:505-508 (2002; "Paul" hereafter). Applicant respectfully submits that the rejection is moot in view of fact that SEQ ID NO: 3588 is taught in U.S. Pat. Appl. No. 60/457,788, which predates the priority date of Mounds. Accordingly, Mounds is not a proper reference under 35 U.S.C. §103.

Applicant further submits that Paul cannot stand alone as a proper § 103 reference. Specifically, Paul does not teach or suggest SEQ ID NO: 3588. In view of the foregoing, claims 21, 23, 32, 33, and 36 are not obvious over the teachings of Paul. Due to the inapplicability of Mounts and the failures of Paul, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 21, 23, 32, 33, and 36 under 35 U.S.C. § 103(a).

3. Conclusion

Applicant respectfully submits that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

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